

COMBINED TRANSMITTAL OF APPEAL BRIEF TO THE BOARD OF PATENT
APPEALS AND INTERFERENCES & PETITION FOR EXTENSION OF TIME
UNDER 37 C.F.R. 1.136(a) (Small Entity)

Docket No.
A-7432

In Re Application Of: Tao Shi GAO

Serial No.
09/935,721

Filing Date
August 24, 2001

Examiner
C. Melissa Koslow

Group Art Unit
1742

Invention: MAGNETIC WRITING SCREEN DISPERSION MEDIUM

TO THE COMMISSIONER FOR PATENTS:

This is a combined Transmittal of Appeal Brief to the Board of Patent Appeals and Interferences and petition under the provisions of 37 CFR 1.136(a) to extend the period for filing an Appeal Brief.

Applicant(s) hereby request(s) an extension of time of (check desired time period):

☒ One month ☐ Two months ☐ Three months ☐ Four months ☐ Five months

from: February 17, 2004

Date

until:

March 17, 2004

Date

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Fee for Appeal Brief: \$165.00

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TOTAL FEE FOR APPEAL BRIEF AND EXTENSION OF TIME: \$220.00

The fee for the Appeal Brief and extension of time is to be paid as follows:

☒ A check in the amount of \$220.00 for the Appeal Brief and extension of time is enclosed.

☐ Please charge Deposit Account No. in the amount of

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☒ Any additional filing fees required under 37 C.F.R. 1.16.

☒ Any patent application processing fees under 37 CFR 1.17.

☒ If an additional extension of time is required, please consider this a petition therefor and charge any additional fees which may be required to Deposit Account No. 08-2455

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**COMBINED TRANSMITTAL OF APPEAL BRIEF TO THE BOARD OF PATENT
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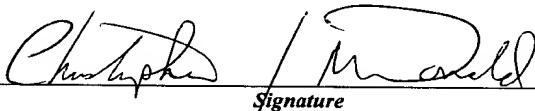
Examiner
C. Melissa Koslow

Group Art Unit
1742

Invention: **MAGNETIC WRITING SCREEN DISPERSION MEDIUM**

TO THE COMMISSIONER FOR PATENTS:

This combined Transmittal of Appeal Brief to the Board of Patent Appeals and Interferences and petition for extension of time under 37 CFR 1.136(a) is respectfully submitted by the undersigned:


Signature

Dated: March 16, 2004

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:

Tao Shi GAO

Serial No: **09/935721**

Filed : **August 24, 2001**

For : **MAGNETIC WRITING
SCREEN DISPERSION MEDIUM**

Examiner:
C. Melissa Koslow

Group Art Unit: **1742**

APPLICANT'S APPEAL BRIEF
UNDER 35 U.S.C. §1.192

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

(1) REAL PARTY IN INTEREST

The real party in interest is Tsuen Lee Metals & Plastic Toy Co., the Assignee of the present application.

(2) RELATED APPEALS AND INTERFERENCES

There are no related appeals and interferences.

(3) STATUS OF CLAIMS

Claims 1-6 and 10-15 are pending and appealed.

(4) STATUS OF AMENDMENTS

An Amendment After Final Rejection was filed September 11, 2003 and was not entered.

(5) SUMMARY OF INVENTION

The invention relates to a magnetic dispersion medium used in a magnetic writing screen toy. The bulk of the magnetic

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dispersion medium is liquid paraffin. Silica is added to the liquid paraffin, as a thickener and titanium oxide is added as a colorant, both present in the range of 1.5 to 3% by weight. A second colorant, benzo oxazole fluorescent whitener, is also present. Iron powder accounts for 13-20% by weight of the mixture. During use, a magnetic tipped pin attracts the iron powder to the top sheet of the magnetic screen toy, leaving a line of black iron particles visible in the white dispersion medium. The viscosity of the dispersion medium retains the iron particles against the screen.

(6) ISSUES

A. Are claims 1-6 and 12-15 properly rejected under 35 USC §112, first paragraph because the specification does not reasonably provide enablement for a magnetic dispersion medium comprising a bulk material or liquid paraffin, a first and second colorant, a thickener and magnetic material or iron powder.

B. Are claims 12 and 11 properly rejected under 35 USC §112, first paragraph as not enabling a dispersion medium comprising a bulk material, a benzo oxazole fluorescent whitener, a thickener and a magnetic material.

C. Are claims 1-6 and 10-14 properly rejected under 35 USC §112, first paragraph as not supported by the specification because the claims do not specify the amount of each component and the composition is not limited to that disclosed in the specification.

D. Are claims 1 and 10 properly rejected under 35 USC §112, second paragraph as being indefinite because the term "bulk material" is unclear.

(7) GROUPING OF CLAIMS

Claims 1-6 and 10-15 stand or fall together.

(8) ARGUMENTS

The Examiner maintains two rejections under 35 USC §112, first paragraph because the specification, being enabling for a magnetic dispersion including liquid paraffin, 1.5 to 3 wt% silica, 1.5 to 3 wt% titania, 0.001 to 0.005 wt% benzo oxazole fluorescent whitener and 13 to 20 wt% steel powder containing up to 17 wt% manganese does not provide reasonable enablement for the magnetic dispersion medium claimed in claims 1-6, 12-15; 10 and 11.

Enablement is measured by whether the specification discloses how to make and use the invention to one of ordinary skill in the art. The detailed description of the invention clearly discloses that the bulk of the liquid dispersion medium is liquid paraffin. Therefore, one of ordinary skill in the art knows that liquid paraffin serves as a bulk material. Every liquid composition needs a bulk material, or carrier, to hold the component in suspension. This is particularly true of dispersion mediums having magnetic material, such as steel. One of ordinary skill in the art would be aware of the liquids that may be used as a bulk material. The magnetic dispersion medium is a well-developed, predictable art, and the materials useable as a bulk material are well understood and known by one of ordinary skill in the art.

Likewise, the specification states that silica functions as a thickener and titanium dioxide and benzo oxazole fluorescent whitener function as a first and second colorant. One of ordinary skill in the art would be aware of other substances that can be used as thickeners or colorants without effecting the function and performance of the magnetic dispersion medium. The specification, therefore, discloses the use of two different colorants.

The specification discloses a magnetic dispersion medium having a bulk material (liquid paraffin), a thickener (silica), and a first and second colorant (titanium dioxide; oxazole fluorescent whitener). The disclosure clearly enables one of ordinary skill in the art to make a dispersion having the subject matter of the claims.

The Examiner maintains a rejection as stating the claims 1-6 and 10-14 are not described in the specification so as to reasonably convey to one of ordinary skill in the art that the inventor had possession of the claimed invention. Specifically, the Examiner states that the disclosure does not support claimed materials where the amounts are not given and the composition is not limited to that disclosed in the specification. The Examiner states that "applicant admits that the claims are broader than the enabled dispersion medium in lines 13-14 in the second paragraph of their arguments on page 3 of the response." This statement is not true as the applicant admits the claims are broader than the disclosed composition, not the enabled composition.

While the specification notes the percent of each component in the composition, therefore disclosing the preferred embodiment and fulfilling the best mode requirement, there is no rationale for limiting applicant to the exact composition disclosed. Claims are always broader than the exact composition, with specifics regarding the composition of the subject of dependent claims. By definition, an independent claim, having dependent claims, is broader than the exact disclosed composition. There is no rationale for limiting the applicant to the exact amounts disclosed in the specification.

The weakness of the two rejections maintained under 35 USC §112, first paragraph, are illuminated by reference to the Amendment After Final Rejection filed September 11, 2003, wherein description was added to the summary of the invention without adding new matter. The Examiner stated that such additions overcame the rejections under 35 USC §112, first paragraph, but denied entry because it was unclear as to what other compounds besides liquid paraffin could be both material.

As noted previously, one of ordinary skill in the art would readily know other substances which could be used as bulk material. Also, the Examiner stated that stating that bulk material is preferably liquid paraffin negates teachings that the

bulk material is liquid paraffin. It is not seen how these two statements are inconsistent or contradictory.


Referring to other prior patents disclosing and claiming magnetic dispersion mediums, it is seen that the claims are not limited to the exact percentage of each composition nor the particular type of each component, such as the exact bulk material, needed in order to obtain patent protection for the composition. Specifically, reference is made to U.S. Patent 4,143,472 (Murata et al) and U.S. Patent 5,419,498 (Ikeda et al).

Lastly, the Examiner rejects claims 1 and 10 as being indefinite since it is unclear what is meant by bulk material. The specification states that the bulk of the material is liquid paraffin. In other words, the liquid paraffin is a bulk material for the composition. As stated earlier, one of ordinary skill in the art, knows that a medium needs a bulk material, or carrier, as a starting point for a composition in order to hold the other components in suspension.

CONCLUSION

The claims are allowable over the prior art and it is respectfully requested that all rejections made by the Examiner be overturned and the application allowed to proceed toward issuance.

Respectfully submitted,


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March 15, 2004

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Attorney Docket No. A-7432.AB/cat

Appendix of Claims

1. A magnetic dispersion medium, comprising:
 - a bulk material,
 - a first colorant, wherein said first colorant is titanium dioxide,
 - a second colorant, wherein said second colorant is benzo oxazole fluorescent whitener,
 - a thickener, and
 - a magnetic material.
2. The magnetic dispersion material of claim 1, wherein said bulk material is liquid paraffin.
3. The magnetic dispersion material of claim 1, wherein said thickener is silica.
4. The magnetic dispersion material of claim 1, wherein said magnetic material is iron powder.
5. The magnetic dispersion material of claim 4, wherein said iron powder contains up to 17 percent manganese.
6. The magnetic dispersion material of claim 4, wherein said iron powder has particles less than 100 microns in diameter.
7. Cancelled
8. Cancelled
9. Cancelled
10. A magnetic dispersion medium, comprising:
 - a bulk material,
 - a colorant, said colorant being benzo oxazole fluorescent whitener,
 - a thickener, and
 - a magnetic material.

12. A magnetic dispersion medium, comprising:
liquid paraffin as a bulk material,
silica for thickening,
benzo oxazole fluorescent whitener, as a first
colorant,
titanium dioxide as a second colorant, and
iron powder.

13. The magnetic dispersion material of claim 12,
wherein said benzo oxazole fluorescent whitener is .005% by
weight.

14. The magnetic material of claim 12, wherein said
titanium dioxide is present in the amount of 1.5% to 3% by
weight.

15. The magnetic material of claim 12, wherein said
silica is present in the amount of 1.5% to 3% by weight.